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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,709	06/30/2000	Guangxin Wang	30-5031(4016)	2249

7590 10/06/2003

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EXAMINER

PHASGE. ARUN S

ART UNIT	PAPER NUMBER
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1753

DATE MAILED: 10/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,709

Applicant(s)

WANG ET AL.

Examiner

Arun S. Phasge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed 8/8/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25, 26, 28-33, 35-40, 42, 43, 45-61 and 63-69 is/are pending in the application.
- 4a) Of the above claim(s) 27, 34, 41, 44 and 62 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25, 26, 28-33, 35-40, 42, 43, 45-61 and 63-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

This application contains claims drawn to an invention nonelected without traverse in Paper No. 8. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 25,26,28-33,35-40,42,43,45-61 and 63-69 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Shindo of record for reasons of record.

Response to Arguments

Applicant's arguments filed 8/8/03 have been fully considered but they are not persuasive.

Applicants begin the argument by attempting to remind the examiner of his duty in examining application. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary

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references. *In re Nomiya*, 184 U.S.P.Q. 607. However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re Simon*, 174 U.S.P.Q. 114; *In re McLaughlin*, 170 U.S.P.Q. 209. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 U.S.P.Q. 545.

All that is required to show obviousness is that the applicant "makes his claimed invention merely by applying knowledge clearly present in the prior art. Section 103 requires us to presume full knowledge by the inventor of the prior art in the field of his endeavor." *In re Winslow*, 151 U.S.P.Q. 48 CCPA (1966).

As stated in prior actions the reference discloses the relative range of the purity of the cobalt as well as the relative ranges of the contaminants.

Applicants state that although the prior art discloses "a broad range of 1 ppm or less of Cr does not indicate or even suggest that the range of less than 0.05 ppm Cr as recited in claim 25 can be achieved."

It is the examiner's position that one having ordinary skill in the art when presented with a disclosure stating 1ppm or less of Cr would comprehend that the

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value is not limited to the 1 ppm but rather that the values including the presently recited values would be obvious within the disclosed range.

Applicants have presented no secondary considerations or other evidence merely arguments which provide little or no patentable weight.

Furthermore, as stated before merely modifying the product of the prior art by purifying the product has been well settled to be obvious modification to a product.

Applicants feel that the applicants' arguments from prior response have not been addressed and seek a response.

Applicants have not addressed how a teaching including the range presently claimed is said not to be teaching that range. Apparently applicants believe that the range of the prior art stops somewhere before the claimed range. It is unclear where this line is drawn, since the reference does not distinguish any such line and clearly encompasses the present range of purity and contaminants.

Applicants further have not addressed that the present product is a mere purified product which has been well settled to have been an obvious product as recited in the prior actions.

Consequently, the invention as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the disclosure of the Shindo patent, because the Shindo patent teaches the broad range of values and modification to the range have been well settled to be within the purview of the ordinary artisan.

Conclusion

This is a RCE of applicant's earlier Application No. 09/608709. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the

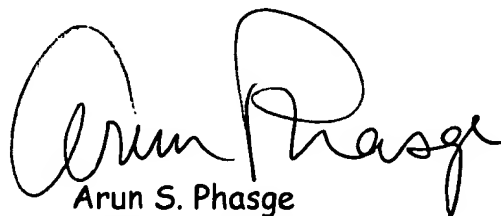
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advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arun S. Phasge whose telephone number is (703) 308-2528. The examiner can normally be reached on MONDAY-THURSDAY, 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam X Nguyen can be reached on (703) 308-3322. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

A handwritten signature in black ink, appearing to read 'Arun Phasge', with a large, stylized initial 'A'.

Arun S. Phasge
Primary Examiner
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